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In re application of :
Krajewski et al. : DECISION ON
Serial No. 10/765,822 : PETITION
Filed : January 27, 2004 :
For: EXTRUDED BIPOLAR PLATES :

This is a decision on the PETITION UNDER 37 CFR 1.144 TO WITHDRAW THE RESTRICTION REQUIREMENT mailed April 19, 2006.

On April 19, 2006, a restriction requirement was made between Groups I and II with the examiner's reasoning that the two inventions are distinct due to differences of the placement of the flow channels and multiple channels provided for different purposes. Applicants traversed the restriction requirement in a response filed May 9, 2006. In their response, applicant argued that the groups are not distinct since both groups provide for multiple channels, Group I calls for the channels to be provided at outside edges of the bipolar plate, and Group II calls for the channels at opposite sides of the bipolar plates.

On May 9, 2006, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement the same as that stated in the response to the restriction requirement.

DECISION

Sections 806.05(j) of the MPEP states in part:

806.05(j) Related Products; Related Processes

To support a requirement for restriction between two or more related product inventions, or between two or more related process inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status in the art, or field of search. See MPEP § 808.02. See MPEP § 806.05(c) for an explanation of the requirements to establish two-way distinctness as it applies to inventions in a combination/subcombination relationship. For other related product inventions, or related process inventions, the inventions are distinct if

- (A) the inventions as claimed do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions as claimed are not obvious variants; and
- (C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 802.01.

The burden is on the examiner to provide an example to support the determination that the inventions are distinct, but the example need not be documented. If applicant either proves or provides convincing evidence that the example suggested by the examiner is not workable, the burden is on the examiner to suggest another viable example or withdraw the restriction requirement.

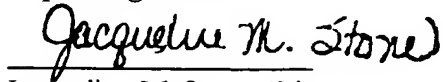
As an example, an intermediate product and a final product can be shown to be distinct inventions if the intermediate and final products are mutually exclusive inventions (not overlapping in scope) that are not obvious variants, and the intermediate product as claimed is useful to make other than the final product as claimed. Typically, the intermediate loses its identity in the final product. See also MPEP § 806.05(d) for restricting between combinations disclosed as usable together. See MPEP § 809 - § 809.03 if a generic claim or claim linking multiple products or multiple processes is present.

The examiner states that Group I and Group II differ in that Group I includes the anode and cathode flow channels being provided at outside edges of the first and second bipolar plates, and that these features are not present in Group II. Additionally, Group II has multiple channels for oxidant/fuel/coolant, which is not required by Group I.

Applicant has responded with the argument that both Groups I and II claim anode and cathode flow channels in the plural, and that Group I claims that the anode and cathode flow channels are provided at outside edges, and that Group II claims that these channels are at opposite sides of the bipolar plates.

As the examiner did not argue that the inventions are independent, and did not set forth a relationship between the groups such as combination-subcombination or species, it is assumed that they are related. As such, to show that related products are distinct according to 806.05(j), both a two-way distinctness and reasons for insisting on restriction are necessary. The inventions are distinct if they do not overlap in scope, they are not obvious variants, and are either not capable of use together or can have a materially different design, mode of operation, function, or effect. The differences pointed out by the examiner do not rise to a showing of distinctness. The placement of the flow channels at outside edges is similar in scope to the placement of the channels at opposite sides of the plates. Examiner's statement that multiple channels for oxidant/fuel/coolant is not provided for by Group I is not convincing as claim 3 provides flow channels for a cooling fluid, and claim 4 specifies flow channels through the middle portion of the plates, which is commensurate with the multiple channels provided by Group II.

Accordingly, the petition for withdrawal of the restriction requirement is **GRANTED**. The application is being forwarded to the examiner to rejoin the non-elected claims and preparing a new non-final office action addressing all pending claims.



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